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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,907	09/07/2004	Noriko Shimozone	Q83226	6781
23373 7590 05/10/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER CHU, YONG LIANG	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 05/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/506,907	Applicant(s) SHIMOZONO ET AL.	
	Examiner Yong Chu	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,12 and 13 is/are rejected.
- 7) ☒ Claim(s) 1,2,6,12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/26/2007</u> <u>8-11-06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a RCE of U.S. Application 10/506,907. The Advisory Action for the original application was mailed to Applicants on 03/19/2007. The request for RCE was received on 03/26/2007. Applicants have submitted amended claims for continued examination. This Office action is for continued examination.

Claims 1-13 are pending in the instant application. Claims 3,4,7-9, and 11 are remained withdrawn.

Priority

This application is a 371 of PCT/JP03/02632, filed on 6 March 2003. Acknowledgement is made of Applicant's claim for Japan Patent Application 1542/02 under 35 U.S.C. § 119(a-d), filed on 7 March 2002.

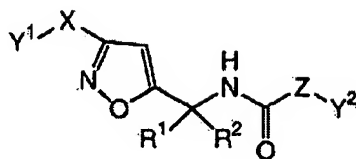
Information Disclosure Statement

Applicant's Information Disclosure Statement, filed on 02/26/2007 has been considered. Please refer to Applicant's copy of the PTO-1449 submitted herewith.

Status of the Claims

Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:



Compounds of formula (I), , wherein:

R¹ and R² are defined as in claim 1;

X represents formula (1) $\alpha - \left(\begin{array}{c} R^3 \\ | \\ -C- \\ | \\ R^4 \end{array} \right)_m - \left(\begin{array}{c} R^5 \\ | \\ -C- \\ | \\ R^6 \end{array} \right)_n - \beta$, wherein R³ to R⁶ are defined as in

claim 1, m is 1 to 3, and n is 0 to 3; Z represents $\left(\begin{array}{c} R^{10} \\ | \\ -C- \\ | \\ R^{11} \end{array} \right)_r$, R¹⁰ to R¹¹ represent are defined as in claim 1, r is 0 to 3, and Y¹ and Y² are a cycloalkyl group, a lower cycloalkenyl group, a phenyl group, a naphthyl group, a heteroaryl group, or an aliphatic hetero ring.

As a result of the election and the corresponding scope of the invention identified supra, claims 5, 10 and the remaining subject matter of claims 1-2, 6, 12 and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups, which are chemically recognized to differ in structure, function, and reactivity. For example Y¹ and Y² are cyclo groups are different from alkyl or alkenyl groups.

Therefore, claims 1, 2, 6, 12 and 13 will be examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "may be substituted" for R^1 , R^2 , X, Z, Y^1 and Y^2 are indefinite. Even though there are definitions in the specification regarding these substituents, it is improper to import claim limitations from the specification. See MPEP§2111.01(II).

Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term ", may be substituted with one or more substituents selected from the group consisting of .." on p13 to p15 are not clearly defined which substituents Applicants intend to refer to. Further more, since there are more than one phenyl, alkyl, or heteroaryl from R^1 , R^2 , X, Z, Y^1 and Y^2 in claims 12 and 13, it is not clear which phenyl, alkyl, or heteroaryl the claims refer to.

Claim Objections

Claims 1, 2, 6, 12, and 13 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

Conclusion


- Claims 1, 2, 6, 12, and 13 are rejected.
- Claims 1, 2, 6, 12, and 13 are objected.

Telephone Inquiry

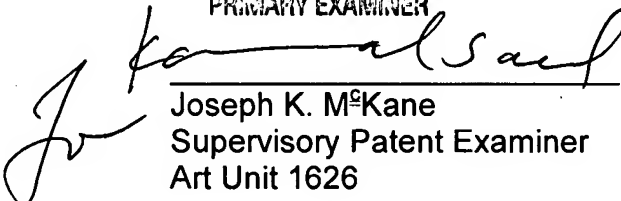
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yong Chu, Ph.D.
Patent Examiner
Art Unit 1626

KAMALA A. SAZED, Ph.D.
PRIMARY EXAMINER


Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626